

REMARKS

Applicant respectfully requests reconsideration. Claims 33, 34 and 44-46 were previously pending in this application. Claims 33 and 44-46 have been amended. New claim 47 has been added. Support for claim 47 is found in the specification, for example at page 15, lines 2-3, and in claim 26 as filed. As a result, claims 33, 34 and 44-47 are pending for examination with claim 33 the sole independent claim. No new matter has been added.

Applicant appreciates the Examiner's consideration of the Information Disclosure Statement filed on August 4, 2004. Applicant respectfully requests consideration of references AB and AC, which were submitted in the Information Disclosure Statement filed on April 9, 2002.

Rejections Under 35 U.S.C. §112

The Examiner rejected claims 33, 34 and 44-46 under 35 U.S.C. § 112, first paragraph, as not enabled. Applicant respectfully requests reconsideration based on the amendment of claim 33.

Applicant has amended the claims to include additional method steps in which the JNK kinase inhibitory activity of a compound is verified *in vitro*, i.e., new steps (a) and (b) of claim 33 as amended.

As indicated on page 2 of the Office Action, the Examiner considers the specification to be enabling for methods in which the "result of testing for apoptosis is coupled with another test that confirms that the compound is a JNK kinase inhibitor."

Accordingly, based on the amendment of the claims as noted above, withdrawal of the rejection of claims 33, 34 and 44-46 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement is respectfully requested.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 33 and 34 as allegedly anticipated by Huan et al., as supported by the Finiels et al. and Borasio et al. references. Applicant respectfully requests reconsideration based on the amendments of the claims and the following remarks.

Huan does not anticipate the invention as now claimed, at least because Huan does not teach incubating a compound in the presence of JNK and a JNK substrate, under conditions sufficient for kinase activity, and determining the presence or amount of a phosphorylated JNK substrate.

In addition, claim 33 is directed to methods for assessing a compound's ability to specifically inhibit JNK kinase activity. In contrast, CEP-1347 is an inhibitor of MLK, and does not specifically inhibit JNK kinase activity. Applicant provides herewith a copy of Maroney et al., J Biol Chem. 276(27): 25302-25308 (2001), which demonstrates that the cellular target of CEP-1347 is the MLK family. See, e.g., the Abstract and the first paragraph of the Discussion section on page 25307.

Accordingly, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 102 of claims 33 and 34.

Rejections Under 35 U.S.C. § 103

1. The Examiner rejected claims 33, 34, 44 and 46 as allegedly unpatentable over the Huan et al., Finiels et al. and Borasio et al. references, in view of the Liu reference. Applicant respectfully requests reconsideration based on the amendments of the claims and the following remarks.

The combination of the Huan, Finiels, Borasio and Liu references does not teach or suggest incubating a compound in the presence of JNK and a JNK substrate, under conditions sufficient for kinase activity, and determining the presence or amount of a phosphorylated JNK substrate, and further do not teach or suggest assessing a compound's ability to specifically inhibit JNK kinase activity. Therefore, the combination of references asserted by the Examiner does not render claims 33, 34, 44 and 46 unpatentable.

2. The Examiner rejected claims 33, 34 and 44 as allegedly unpatentable over the Maas et al. reference, in view of the Huan et al. and Finiels et al. references. Applicant respectfully requests reconsideration based on the amendments of the claims and the following remarks.

The claims as amended recite incubating a compound in the presence of JNK and a JNK substrate, under conditions sufficient for kinase activity, and determining the presence or amount of a phosphorylated JNK substrate. Accordingly, for at least this reason, the combination of the Maas, Huan and Finiels references does not teach or suggest the claimed invention.

3. The Examiner rejected claims 33, 34, 44 and 46 as allegedly unpatentable over the Maas et al., Huan et al. and Finiels et al. references, in view of the Liu reference. Applicant respectfully requests reconsideration based on the amendments of the claims and the following remarks.

As discussed above, the combination of the Maas, Huan and Finiels references does not teach or suggest the claimed invention. The combination of these references, along with the Liu reference, also does not teach or suggest the claimed invention.

Accordingly, based on the amendments of the claims and the arguments presented above, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103 of the claims.


CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No: 23/2825.

Respectfully submitted,
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